

Discussion

The applicant hereby adopts and repeats its submissions made in support of the unamended claims in the prior Response. In response to the examiner's office action of February 2, 2011, the applicant makes the following further remarks.

Principles of sections 102, 103

"All truths are easy to understand once they are discovered; the point is to discover them."

Galileo Galilei

The applicant has begun with this quotation because all of the examiner's responses are based on the premise that each of the claims 21 through 40 of the pending application are all obvious in view of the prior art cited by the examiner.

There is an immense amount of jurisprudence around what constitutes obviousness. The applicant will not refer to all of this source material but will make reference to some special clarifying thoughts on the subject. To commence, section 103 will now be quoted as follows:

35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The undersigned attorney likes to explain the principles of patent law to inventors and others by referring to the "Golden Rule" of patent law. Simplifying the language of sections 102 and 103, the Golden Rule is that a patent may not attempt to take away from the public anything that was previously available to the public. "Available to the public" appears in the text of the Patent Cooperation Treaty and is included in the new legislation pending before Congress, corresponding to Senate Bill S. 23. This expression addresses everything known previously in the prior art. But logically, anything which is "obvious" in view of the prior art would also be "available to the public". So section 103 is really an extension on section 102.

These combined sections protect the public from the importune issuance of a patent which takes away from the public their freedom to do something that was previously available to be done. Seen in this context, "obvious" properly describes things that would be readily apparent to "a person having ordinary skill in the art to which said subject matter pertains" as being an available option without the necessity for such a person to exercise inventive initiative.

Taking an alternate policy approach analysis, section 103 is intended to bar issuance of claims which covers subject matter which ordinary non-inventive individuals would readily adopt in the normal course. The fact that something has not already been done by the time an applicant files for patent has got to carry some weight in arguing that what the applicant proposes is beyond being merely obvious.

Examiner's rejection based on obviousness

In the case of this particular invention, the examiner has rejected claims 21-25, 28, 30-33, 37-40 on the basis of 35 US 103, applying the applicant's own prior patent US 6, 244, 005 and US patent 5, 511, 761 to Schultz. In doing so, the examiner states that:

"... it would have been an obvious matter of design choice to one of ordinary skill in the art to modify the wall panel of Wallin, including a footing, to have the footing formed to by a footing form as disclosed by Schultz so that it is attached to and position beneath and extending laterally from the flange forms to provide a wall assembly that is easy to construct; whereby the footing form can be filled with binder material that serves as a footing along the base end of the panel, interconnected, covered, footing volume to extend between two adjacent wall panels (were Schultz discloses that the footing form attached to and positioned lateral to the wall portion and is open to the interior of the wall portion to allow the binder material to flow from one to the other creating a continuous wall/footing assembly".

If the above assertion by the examiner presumes that there is a wall portion in Schultz, then this understanding is incorrect. Schultz addresses both a wall and footing form for forming an entire wall together with its footing by casting concrete on site. Schultz does not include a precast component. According to the present invention no solid wall is cast on-site. The wall portion of the invention is precast, or preformed, off-site. The examiner surely recognizes this but the applicant has to make this distinction between prior Wallin and Schultz clear for the record.

Next, the above assertion by the examiner starts off with the premise that the person making the "design choice" has already perceived the concluding structure that they are going to create. But part of an inventive step is the perception that something can be created. The applicant submits that the combinations that the examiner proposes would not be readily recognized as available to ordinary non-inventive individuals, even though they may be skilled in the art.

It is not sufficient for the examiner to assert that if one were to take the present applicant's earlier patent with its precast footing and substitute for that precast footing by attaching a footing form similar (note that it is not identical) to that of Schultz, then this will produce the invention as claimed. The issue has to include whether even proceeding to make such a

combination would be obvious. The applicant says that this initial, essential, step would not be obvious.

But there are further barriers to making the combination that the examiner has proposed.

The modifications required to combine prior Wallin and Schultz include:

1. To convert the prior Wallin panel to the new system of present claim 21 requires removal of the precast footing from the prior Wallin wall design. This is a first modification to the prior Wallin configuration.
2. Schultz's footing form cannot be fitted against the precast wall panel of the prior Wallin wall panel without cutting away portions of the flange forms. This is a second modification to the prior Wallin panel.
3. If you did cut away portions of the flange forms and simply fitted Schultz's footing form at the bottom of the previous Wallin wall panel, Schultz's footing form would not fill with concrete. You would have to cut openings in Schultz's form. This is a modification to the Schultz footing form.
4. In the case of Schultz, the light-weight side wall pouring forms of Schultz are supported by Schultz's footing form from the top edge of Schultz's form. A Schultz footing form placed on one side of a preformed Wallin wall panel along its bottom edge would not support the Wallin preformed wall panel because of the weight. The Wallin wall panel would have to extend downwardly to the ground, to the same level as the bottom outer edge of the Schultz footing form so that both can rest on the ground at the same level. This is a third modification to the prior Wallin panel.
5. Unlike Schultz, the footing form for the prior Wallin panel is not removed but is retained to serve as reinforcement. (See the further discussion below for the difference between Schultz and Wallin on this point).

With all of these changes in mind we have to ask the questions:

1. Why would someone decide to remove the preformed footing from the prior Wallin wall design?
2. Why would someone decide to cut away bottom portions of the flange forms of the precast